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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,795	07/03/2001	Douglas J. Murray	BAO-0021	1868

7590 02/07/2005

CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002

EXAMINER

THOMPSON, KENNETH L

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JE

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Office Action Summary

Application No.

09/898,795

Applicant(s)

MURRAY, DOUGLAS J.

Examiner

Kenn Thompson

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 18-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18, 20-23, 25, 26 and 28 is/are allowed.
- 6) ☒ Claim(s) 12-14, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 15, 19 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-14, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Metcalfe et al., U.S. 6,446,323.

Regarding claim 29, Metcalfe et al. discloses in figure 3 a non-diverter tubular sleeve (34) composed of a single piece of material at least a portion of which is circumferentially closed. Metcalfe et al. discloses the sleeve having a wall thickness selected to minimize restriction of a borehole in which the sleeve is installable and insufficient to divert and sufficient to orient a tool (col. 1, lines 37-42). Metcalfe et al. discloses an expandable section (opposite 30) being radially expandable to assume a larger circumferential dimension such that an interference fit with a wellbore in which the sleeve is to be deployed is achievable. Metcalfe et al. discloses an orientation profile (30) disposed at an axial end of the sleeve.

As to claims 12 and 13, Metcalfe et al. discloses the orientation profile has an opening or slot (groove or slot 30) therein.

As to claim 14, Metcalfe et al. discloses the profile is proximate the wellbore casing (32).

Regarding claim 30, Metcalfe et al. discloses a sleeve (34) and expandable portion (upper end) and an orientation profile (30) to orientate a tool (col. 1, lines 37-42).

Allowable Subject Matter

Claim 18, 20-23, 25, 26 and 28 are allowed.

Claims 15, 19 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including the orientation opening extends along a wall of the tubular member from the orientation profile and is configured to receive a pin on a tool to orient the same.

The prior art of record does not disclose or suggest all the claimed subject matter including the expandable section of the of the sleeve being at a downhole end of the sleeve having a lesser thickness than an uphole end of the sleeve.

Response to Arguments

Applicant's arguments filed 24 November 2004 have been fully considered but they are not persuasive.

Applicant argues the prior art does not disclose an orientation profile, rather what is taught in the reference is a latching profile, which provides no indication of orientation of a tool and no assistance with respect to orientating a tool.

Metcalf et al. discloses in column 1, lines 37-42, the profile may permit or facilitate the location of tools or devices in the tubing at the profile location, and alternatively, the profile may serve as a reference point. The profile of the prior art provides at least an axial orientation means, the claims being absent limitations precluding the comparison.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1 February 2005



Kenn Thompson
Primary Patent Examiner
Art Unit 3672